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<b>TRANSMITTAL FORM</b>  <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/868,244
	Filing Date	July 10, 2001
	First Named Inventor	Mikko Sievänen
	Group Art Unit	3711
	Examiner Name	W. Pierce
Total Number of Pages in This Submission	Attorney Docket Number	19380.0006

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Date	April 3, 2003

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R. Kent  
4/9/03  
#17/Request  
Reconsider

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Sievänen et al.

Application No.: 09/868,244 /

Filed: July 10, 2001

Attorney Docket: 19380.0006

Art Unit: 3711

Examiner: W. Pierce

Title: CONSTRUCTION ELEMENT FOR A BOWLING LANE AND A BOWLING LANE

Response To Office Action

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

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This is in response to the office action issued January 3, 2003.

Claims 11-22 and 24-27 are now pending in this application. Applicants respectfully request favorable reconsideration of this application.

The present invention as recited in independent claim 11 provides a construction element for a sectional bowling lane. The construction element includes at least one laminate layer, at least one board layer, and at least one supporting structure layer including a cellular structure made of one or more pieces and positioned to support the at least one laminate layer and the at least one board layer. The construction element is configured to be operatively connectable to at least another construction element.

The present invention is directed to a bowling lane construction element. As such, the construction element is capable of withstanding the forces that a bowling lane typically encounters. Due to its unique construction, the present invention can greatly reduce the weight of a bowling lane as compared to known bowling lane constructions. Also, the present invention makes it possible to erect a lane for temporary use. The present invention also provides a very stable bowling lane construction. The invention represents a completely new way of thinking in the field of bowling lanes that none of the cited references disclose or suggest.

The Examiner rejected claims 11-27 under 35 U.S.C. § 103(a) as unpatentable over Honeycomb Products in view of Paneltec.

The Honeycomb Products and Paneltec references are not valid references since neither one includes a valid publication date that makes them a valid reference under 35 U.S.C. § 103. The only date that appears on the references is June 12, 2002. The priority application for this case was filed December 18, 1998, **over three-and-one-half years earlier**. Contrary to the Examiner's assertion, a reference with such age in no way suggests the state of the art at the time the present invention was made.

The Examiner cites *Ex parte Erlich*, 22 U.S.P.Q.2d 1463 (Bd. of App. 1992), as supporting his contention that a post-dated reference can serve to show the state of the art at the time an invention was made. However, the post-dated reference in *Erlich* cited "a large number of references bearing publication dates" at the relevant prior date. The Examiner has not pointed out the citation in Honeycomb Products or Paneltec of such numerous references to articles

having a date relevant to the present invention. **This because such references do not exist.**

Therefore, the citation of *Erlich* is irrelevant and Honeycomb Products and Paneltec are not valid references in this case.

Additionally, the version of Paneltec supplied by the Examiner states on page 1 that, "Honeycomb lamination is relatively new." Furthermore, Paneltec has changed its web site since the Examiner printed this version. No evidence exists that the contents of the Paneltec web site printed by the Examiner correspond to the contents of the web site at a time relevant for the reference to serve as a valid reference. Therefore, the Paneltec reference is not a valid reference against the claims of the present application.

Similarly, the pages of the Honeycomb Products web site supplied by the Examiner have a June 12, 2002 date. These references simply are not valid references. Neither has a date even before the priority date of the present application, much less a sufficient time before the priority date. There is no way to determine from this reference the level of the skill of the art at the time the present invention was made based upon these references. Based solely upon the date of the Paneltec and Honeycomb Products references, the rejections based upon these references should be withdrawn.

For some unknown reason, contrary to the dates printed on the references, in the for PTO-892 supplied by the Examiner with the office action issued June 19, 2002, the Examiner provides publication dates of December 1998 and June 2001 for Honeycomb products and Paneltec references, respectively. Both dates make the references ineligible as references against

the claims of the present application.

Even if either of these two references were validly available as references in this application, they would not suggest the present invention. Simply showing a honeycomb construction does not suggest the present invention.

Contrary to the Examiner's assertion, the present invention is not merely the use of honeycomb panels in a bowling alley. Clearly as recited in the claim, the present invention is not just honeycomb panels intended for use in a bowling lane. The present invention is a multilayer structure that includes as one of the layers a honeycomb panel. However, the present invention also includes other layers.

Including known materials does not make an invention anticipated or obvious. Certainly mechanical inventions are typically made of known materials and utilize known principles. However, the way that these known materials are put together is new. This is the case with the present invention.

In the rejection, the Examiner states that using honeycomb panels "would have been an obvious matter of design choice". However, the Examiner does not give any reasoning why one would make such a substitution. It is known buckling and warpage effects can occur in connection with honeycomb structures. These buckling and warpage effects are highly undesirable features in the construction element for a bowling lane. In view of the above, one of ordinary skill in the art would not consider utilizing a honeycomb structure in a bowling lane

construction element.

The Examiner cites *In re May* as support for his contention that Applicants are simply claiming a new use of an old material. However *In re May* is distinguishable from the present case since, among other things, it appears as if May only discovered a new property of an existing substance. The court stated that this did not "constitute a new use".

Unlike *In re May*, the present invention is a new composition. The present invention is also a new structure for a bowling lane floor. The present invention is not just a honeycomb panel and it is a mischaracterization to state so. The present invention is also not an old composition of matter or structure. This is evidenced by the fact that the Examiner cites a combination of references that even in combination do not suggest the claimed structure of the present invention.

Applicants have never claimed to be the inventors of honeycomb panels or any of the other layers that make up the construction element of the present invention. Nor are Applicants only claiming honeycomb panels. However, Applicants have invented a new bowling alley construction element that is inexpensive, light weight, can be easily assembled and disassembled, and endures humidity and temperature changes better than known bowling alley construction elements.

The court in *In re Burke Inc.*, 22 U.S.P.Q.2d 1368 (C.D. CA 1992), found that a combination of elements is patentable. Along these lines, the court found that a claim for three-

wheeled "personal mobility vehicle" is not obvious, even though individual elements of claim were known in prior art, since claim discloses flexibility in use of vehicle both indoors and outdoors at particular sites, and convenient separation of vehicle into components small and light enough for easy transportation, as new or different function flowing from claimed combination.

Similarly, in *Ex parte Hiyamizu*, 10 U.S.P.Q.2d 1393 (Bd. of App. 1988), the Board of Appeals found that, "It is to be noted, however, that citing references which merely indicate that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious." In this case, Applicants are claiming a unique combination of layers that is not obvious based upon the cited references.

Additionally, the present invention is directed to a bowling alley construction element. The recitation in the preamble of a bowling alley construction element breathes life and meaning into the claim. In other words, the present invention is not directed to panels for use in any application. Rather, the present invention includes panels that fulfill all of the requirements that a bowling alley must fulfill. These requirements include the ability to withstand the impact of a bowling ball. In fact, a bowling lane forms an essential part of a game that has strict rules governing all aspects of the game.

A preamble that recites intended use may act to define an invention. As stated by the court in *Corning Glass Works v. Sumitomo Electric U.S.A. Inc.*, 9 U.S.P.Q.2d (Fed. Cir. 1962), a

preamble may "not merely state a purpose or intended use for the claimed structure." In Corning Glass Works, "the inventors were working on the particular problem of an effective optical communication system not on general improvements in conventional optical fibers."

In finding that the preamble added meaning to the claim, the court stated that reading "the claim in light of the specification indiscriminately to cover all types of optical fibers would be divorced from reality." Furthermore, the court stated that, "The invention is restricted to those fibers that work as waveguides as defined in the specification.". The court concluded "that the claim preamble in this instance does not merely state a purpose or intended use for the claimed structure," and that the preamble gave "life and meaning" to the claim and provided "further positive limitations to the invention claimed."

Bowling lanes have certain requirements. The present invention provides a structure that satisfies these requirements; the claims recite this. As a result, the present invention is not claiming all composite construction element, only those that include the layers recited in the claims and, further, that satisfy the requirements of bowling lanes.

In addition to the honeycomb layer, the present invention includes other layers. The present invention is not simply a floor structure. It must satisfy the requirements of a bowling lane. None of the cited references suggest a bowling lane structure that includes the combination of layers and a combination of layers that meets the recited requirement of being a bowling lane.

Even if they were valid references, neither Honeycomb Products nor Paneltec suggests a



structure that is a bowling lane construction element. For example, Honeycomb Products suggests a honeycomb structure made of kraft paper, which is certainly unsuitable for use in a bowling lane construction element at least in part due to its inability to withstand the loads that a bowling lane is subject to. Also, if such structure become wetted or dirty, the effects would not be reversible. The nature of the loads that the Honeycomb Products are capable of withstanding are discussed in the reference. These examples are much less than the loads that a bowling lane is subjected to.

Brunst does not suggest the present invention since, among other things, Brunst does not suggest the layer construction of the present invention. Along these lines, Brunst suggests a panel member for a bowling lane. The panel member is made of wooden strips attached together. In other words, the wooden core is solid. A high pressure laminate member is adhered to each face of the wooden panel. Brunst suggests a panel type structure but the actual details of the panel do not suggest the structure of the present invention. For example, Brunst does not include any suggestion that the panel should be made lighter.

Beamish does not suggest the present invention since, among other things, Beamish does not suggest a bowling lane construction element that includes the layers recited in the claims. Beamish suggests a method for producing a composite structural member free from distortion or buckling. However, as described at col. 2, lines 1-68 and col. 3, lines 1-4, Beamish suggests that is it not possible to press the face plates and the core together and still obtain a structure free from distortion or buckling.

Additionally, Beamish suggests that that the parts to be attached shall be heated beforehand to obtain structural members free from distortion or buckling. *See* col. 3, lines 1-70, col. 4, lines 1-2 and claim 1. Thus, Beamish teaches away from the present invention because the method that is capable of producing distortion free structural members cannot be applied on construction elements of a bowling lane due to materials used in bowling lanes. One of ordinary skill in the art would not apply the method suggested by Beamish on a bowling alley construction element since the requirement of heating expandable material, such as metal, in the board layer is not suitable for bowling lanes as a result of a lack of impact resistance and noise, among other things.

Furthermore, the method suggested by Beamish would create huge problems in attaching the laminate layer. Significantly, the construction element would not fulfill the requirements of a bowling lane. As a result, one of ordinary skill in the art would not utilize the method of Beamish since it would not work and would see that laminating or pressing the parts together would not be worth trying.

In view of the above, the references relied upon in the Office Action, whether considered alone or in combination, do not suggest patentable features of the present invention. Therefore, the references relied upon in the Office Action, whether considered alone or in combination, do not make the present invention obvious. Accordingly, Applicants respectfully request withdrawal of the rejection based on the cited references.

In conclusion, Applicants respectfully request favorable reconsideration of this case and


early issuance of the Notice of Allowance.

If an interview would facilitate the prosecution of this application, Applicants urge the Examiner to contact the undersigned at the telephone number listed below.

The undersigned hereby authorizes the Commissioner to charge insufficient fees and credit overpayment associated with this communication to Deposit Account 19-5127, 19380.0006.

Respectfully submitted,

Date: 4-3-03

  
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